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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,831	10/11/2001	Kamal Acharya	NETS0085	3000
22862 7590 10/27/2009 GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025				
EXAMINER DUNHAM, JASON B				
ART UNIT		PAPER NUMBER		
3625				
NOTIFICATION DATE		DELIVERY MODE		
10/27/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eptomatters@glenn-law.com

## Office Action Summary

**Application No.**

09/975,831

**Applicant(s)**

ACHARYA ET AL.

**Examiner**

JASON B. DUNHAM

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 7, 8, 10, 11, 14, 18-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7-8, 10-11, 14, 18-20, and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant canceled claims 9, 12-13, 15-17, and 21 and amended claims 1, 7-8, 10-11, 14, 18-20, and 22-23 in the response filed July 17, 2009 in reply to the office action dated March 17, 2009. Applicant's amendments to independent claim 1 rendered the previous 35 USC 101 rejection moot. Claims 1, 3, 7, 8, 10, 11, 14, 18-20 and 22-25 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 7, 8, 10, 11, 14, 18-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pricescan (PTO-892, Ref. U) in view of McGlinn (US 2002/0152134) and further in view of Biswas (US 6,594,666).**

Referring to claim 1. Pricescan discloses a method for providing an integrated electronic list of providers, comprising the steps of:

- a processor determining at least one online provider for an item (Pricescan: page 4);
- a processor determining at least one offline provider for an item (Pricescan: page 4);
- a processor integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item (Pricescan: page 4);

Pricescan does not explicitly disclose distinguishing online from offline providers in a list and providing comparison information. McGlinn discloses:

- a processor distinguishing online providers from offline providers in said integrated list (McGlinn: abstract) and providing comparison information including user reviews, electronic wallet comparison, return policy comparison, in-store return and pickup policies of online purchases; and promotions and coupon availability information for the at least one online provider and the at least one offline provider for the item (McGlinn: figure 9 disclosing offline providers as "real storefront certified") It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Pricescan to have included distinguishing online from offline providers, as taught by McGlinn, in order to increase consumer trust (McGlinn: abstract).

The examiner notes that the type of comparison information (user reviews, electronic wallet, etc.) is non-functional descriptive material. Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate- In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II

The combination of Pricescan and McGlinn discloses searching by physical location (McGlinn: paragraph 23) but does not explicitly disclose a user choosing a target location or radius. Biswas discloses:

wherein, responsive to a determination of when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored (Biswas: abstract and column 5, lines 25-30);

wherein, responsive to a determination of when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location (Biswas: abstract and column 5, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined the known method of Pricescan and McGlinn disclosing searching by physical location with the known method disclosed by Biswas of including requests for geographical areas wherein a user may choose a target location and requests for a proximity to a target location wherein a user may choose a radius to said target because it is merely combining known techniques to yield a predictable result. Such combination is rendered obvious under KSR. See KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Referring to claim 3. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the request is for a product category (Pricescan: Page 3).

Referring to claims 7-8, 10-11, 14, and 18-20. The combination of Pricescan, McGlinn and Biswas further discloses methods wherein the comparison information includes price, rating, availability, special promotion, at least two offline providers,

coupon availability, and proximity and direction to the at least two offline providers (Pricescan: pages 3-12). Please see the examiner's notes above in the rejection of claim 1 noting the type of comparison information as non-functional descriptive material.

Referring to claims 22-23. Medium and system claims 22-23 are rejected under the same rationale set forth above in the rejection of method claim 1 containing similar limitations.

Referring to claims 24-25. The combination of Pricescan, McGlinn and Biswas further discloses a system implemented on a network environment and further comprising a global communications network (Pricescan: pages 3-12 disclosing a website implemented on a system utilizing the world wide web).

### ***Response to Arguments***

Applicant's arguments filed July 17, 2009 have been fully considered but they are not persuasive. Applicant argues that the combination of Pricescan, McGlinn, and Biswas does not disclose different types of comparison information of online and offline merchants as recited in claims 1 and 18 (user reviews, electronic wallet, in-store return and pickup policies, return policy, promotion, and coupon availability). The examiner disagrees as the type of comparison information is merely directed towards non-functional descriptive material and does not distinguish the invention from the prior art in terms of patentability. Please see the examiner's note in the rejection of claim 1. Independent claims 22 and 23 and the respective dependent claims of claims 1, 22, and 23 are rejected under the same rationale.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason B Dunham/ 10/22/09  
Primary Examiner, Art Unit 3625